



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/561,439

03/30/2006

Martin Gijs

Q92227

6377

23373

7590

11/21/2008

SUGHRUE MION, PLLC

2100 PENNSYLVANIA AVENUE, N.W.

SUITE 800

WASHINGTON, DC 20037

EXAMINER

TRINH, MINH N

ART UNIT

PAPER NUMBER

3729

MAIL DATE

DELIVERY MODE

11/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,439	Applicant(s) GIJS ET AL.	
	Examiner Minh Trinh	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 9, 16-23 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/20/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species IA in the reply filed on 10/15/08 is acknowledged. Applicant's response to the Office's Restriction has been duly considered but is held to be without merits. Applicant's response is not persuasive because the reasons proffered are not relevant to an election of species, the restriction /election for the election of species is found at Section 808.01(a) in the MPEP. Once claims are determined to be directed to mutually patentable inventions and the Office requires an election of species (refer to previous Action, paragraphs 1-4), a persuasive traverse is an admission on the record that Applicant did not demonstrate that the claimed species are individually patentable, Applicant's reasons therefore are not persuasive. Applicant is not entitled to examination of multiple independent inventions in one application. Moreover, examination of the independent inventions herein would present a serious burden to the Office in as much as the searches are not coextensive and the art is quite prolific Accordingly, the requirement is repeated and **MADE FINAL**.

2. Claims 9, 16-23 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species IB, IC, there being no allowable generic or linking claim. Election was made w/traverse in the reply filed on 10/15/08.

An office action on the merits of claims 1-8, 10-15 and 24-25 as follows.

Claim Objections

3. Claim Claim1-8, 10-15 and 24-25 are objected to because of the following informalities

“Method” (claim1, line 1) should be changed to:-- A method--.

“Method “(2-8, 10-15 and 24-25, line 1) should be changed to:--The method--.

It is not known what strip laminate is being referring to in the claim since claim 1 recites at least 4 strips from different embodiment of the inventions i.e., 1, 10, 13, 100. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 10-15 and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the claims is unclear because claims directed to a method however claim directed to a material structure such as a laminate strip (claim 1, line 4-5, claim 2, line 1-2, etc., which made scope of the claims unclear.

In this case, claim recites a laminate strip (i.e., 1, 10, 13, 100) (see claim 1, line 3), and the cutting of one part (6, 6', 16A-D, 54, 100) which is confusing and not understood because there is more than one strip recited in the claim and further, it is unknown which one of the part is being cut (claim 1, line 5-6) since claim recites a

Art Unit: 3729

number of unrelated parts to be cut. (similar to this found in claims 4-6, 10, etc., respectively.

“ the cutting operation” (claim 1, line 7) lacks proper antecedent basis.

It is unclear as to what exactly is referring as a layer (3, 31, 310) since claim recites at least 3 layers (see claim 2).

Claim 1 appears to be incomplete because in prior to the etching step there must be a number of process steps such as: laminating a number of strip to form a laminated stack and providing a mask and using a mask as template for etching, and final etching by means of sandblasting , etc to form a desired cavity or recess in the stack, etc.

whether “an adhesive material “(claim 3, line 3) is as same as that in claim 1, line 4 or not.

“having at least one shape according to which it is desirable” (claim 4, line 5) is indefinite and confusing in that it is unknown what is being referring as the shape of the opening?

The phrase:” is constituted” (claim 9, line 2); “in order to carry out” (claims 10, 12, line 2); “is adhesive bonded”(claim 10, line 3); “ are separated”(claim 11, line 2); “is placed” (claim 12, line 2); “are connected” (claim 13, line 3); “ are separate” (claim 13, line 4); “are carry out” (claims 24-25, line 5) and many others are not positively method limitations, since claims directed to method of making therefore it is suggested the use of positively method limitations such as: step of performing ; forming; adhering, bonding, separating ; connecting, etc., are suggested.

“a plurality of parts” (claim 13, line 2) does not agree w/ that in claim 1, line 5.

Claims 1-8, 10-15 and 24-25 are incomplete because there is no product obtains at the end of the very final process.

Further, many terms, phrases set forth in the claims are not understood. Applicants' cooperation is requested in correcting any errors of which applicant may become aware in the claims and/or specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8, 10-15 and 24-25 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Takiguchi (6,010,956).

Takiguchi discloses a method for producing parts for passive electronic components comprising:

cutting method which comprises at least one step involving etching by means of sandblasting (see abstract, and Figs. 1A-1D).

Note the limitations such as : - a laminated strip (1, 10, 13, 100) is produced which is constituted by at least one stack of a thin and fragile metal strip (2, 21, 210) and a layer of an adhesive material, - and at least one part (6, 6', 16A, 16B, 16C, 16D; 54; 100) is cut from the laminated strip (1, 10, 13, 100), are intended used because they are recited in the preamble.

Art Unit: 3729

Limitations of claims 2-8, 10, 11,14-15 appear to be met by the reference since no additional method limitations recited in these claims (see col. 31, lines 57-60, col. 32, lines 1-10 for the teaching of laminate stack and the performing of sandblasting etching, etc.

7. Regarding claims 12-13 and 24-25 there is no art rejections have been applied to claims 12-13 and 24-25, since there are a great deal of confusion an uncertainty as to the proper interpretation of the limitations of the above claims. Therefore, it would not be proper to reject such claims on the basis of prior art. See MPEP 2173.06.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3729

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/19/08

/Minh Trinh/
Primary Examiner, Art Unit 3729

mt